

**REMARKS**

As an initial note, the Applicants wish to thank the Examiner for acknowledging that Claims 4, 5, 14 and 15 include allowable subject matter. The Applicants have amended Claims 1-22 without prejudice as to patentability including the doctrine of equivalents, with Claims 4 and 5 written in independent form. The Applicants have also added new Claims 23-30. Accordingly, Applicants respectfully submit that Claims 1-30 are in condition for allowance. The Applicants also submit that these minor amendments and corrections herein are made without prejudice, were not necessary to overcome the cited references, and that no new matter has been added.

**Claims 29-30 and 36-37 Satisfy 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected Claims 11-20 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants have amended the claims to more clearly identify that the sub-combination "operation counter assembly" is being claimed. The originally filed written description and/or Figures (see e.g. para. [0037]) provide sufficient support for the subject claims, as currently amended.

**Claims 1-3, 6, 7-10, 11-13, 16, and 17-22 are not Obvious.**

The Examiner rejected Claims 1-3, 6, 7-10, 11-13, 16, and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,861,595 by Wood et al. in view of U.S. Patent No. 6,300,585 by Nicolai et al. The Applicants respectfully traverse the rejection.

Nicolai et al. describes an operational counter arrangement 10 used to count the number of operations of a load brake tool 18 having: an exhaust control assembly 20; and a trailer portion 14 made of arc-extinguishing material which protrudes into the exhaust control assembly 20. *See* col. 3, lines 24-39 and FIGS. 1-3. The operation counter arrangement 10 is disclosed as being either affixed to the load brake tool 18 by "incorporate[ing the arrangement 10] into the exhaust control assembly 20 or via the assembl[ing] . . . the operational counter arrangement 10 into the existing

exhaust control device 20 as illustrated” in FIGS. 1-3. *See also* col. 3, lines 39-43. Movement of the trailer portion 14 causes movement of actuator 30 which engages an operational counter switch 34. *See* FIGS. 1-3 and col. 3, lines 44-46.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, and most significantly, the references when combined must teach or suggest all the claim limitations. The proposed combination of Nicolai et al. and Wood et al. would not result in the Applicants' invention because it would not provide either a portable circuit interrupting apparatus as described in application Claim 1 or new Claim 23 or an operational counter assembly as described in application Claim 11, but would instead provide the modified load brake tool 18 as described in Nicolai et al.

As stated in the background section of the application (para. [0007]), Applicants recognized that counters such as that disclosed by Nicolai et al. are prone to excessive wear because part of the counter mechanism is in contact with arc-interrupting components or shunt interrupting circuits which are subject to the wear and tear or other forms of degradation caused by arcing resulting from the circuit interrupting operation. As such, the Applicants recognized a need for an interrupting apparatus which can count the number of operations performed by each circuit interrupting apparatus and that does *not* require direct interface with interrupting circuit components such as exhaust control assembly 20 and trailer portion 14. The present application is an improvement over Wood et al. (incorporated by reference) disclosing such an interrupting apparatus but with the addition of an operational counter assembly.

More specifically, the combination of Nicolai et al. and Wood et al. does not teach or suggest the claimed structures. For example, with respect to Claims 1, 11, and 21, and new Claims 23 and 29, Nicolai et al. fails to disclose, teach, or suggest an operation counter connected to or associated with a “reset plunger.” With respect to Claim 22, Nicolai et al. fails to disclose, teach, or suggest an operation counter incremented directly in response to either extension or retraction of the reset plunger through the medial portion of the main sleeve body. Nothing in the Nicolai et al.

structure of either actuator 30 or extension 32 implies that such components "reset" the load break tool 18, and thus, cannot be considered a reset plunger. The Application describes a reset plunger (76) as a device that is structurally configured to releasably lock sleeve (36) in its extended position until manually released by user manipulation of the reset plunger (76). *See* Application para. [0038] and FIGS. 4-6. Nicolai et al. lists various U.S. patents that provide a description of a load break tool to which its operational counter can be utilized, such as, for example, U.S. Patent No. 5,650,602, by Wood et al. developed by two of the inventors listed for the present application, parent of the cited patent U.S. Patent No. 5,861,595 by Wood et al., and assigned to Utility Solutions, Inc., the assignee of the present application. This patent illustrates a release pin 76 which is best equated with the reset plunger (76). The Nicolai et al. operational counter 10 is not in any way disclosed or described to be connected to or interfaced with such reset pin 76. Thus, none of the cited patents disclose an operation counter connected to, interfaced with, or directly actuated by a "reset plunger" of a circuit interrupting apparatus. Actuator 30 and extension 32 are, in fact, just extensions of the Nicolai et al. operational counter switch mechanism. *See* FIGS. 1-3.

With respect to new Claim 26, Nicolai et al. fails to disclose, teach, or suggest an operational counter adapted to be connected to a portion of the main housing body of a circuit interrupting apparatus at least partially external to the main housing body outer surface, separate and spaced apart from an exhaust control assembly of the circuit interrupting apparatus. Nor is the Nicolai et al. operation counter counter assembly 10 adapted to be positioned to count a number of circuit interrupting operations of the circuit interrupting apparatus indicated by substantially full operational extension of the main sleeve body. Rather, the Nicolai et al. operational counter assembly 10 responds to movement of the trailer portion 14 of loadbrake tool 18 either to or from extending portion 32 of actuator 30, compressing or releasing compression spring 37. *See* Nicolai et al. FIGS. 1-3 and col. 3, line 43 to col. 4, line 24.

With respect to new Claim 28, Nicolai et al. fails to disclose, teach, or suggest an operational counter adapted to be connected to a medial portion of the main housing body of a circuit interrupting apparatus substantially external to the main housing body outer surface, separate and spaced apart from an exhaust control assembly of the circuit interrupting apparatus. Nicolai et al. instead discloses an operation counter arrangement 10 incorporated into an exhaust

control assembly 20 or assembled into an existing exhaust control device 20 as illustrated in FIGS. 1-3. *See* col. 3, lines 39-43. Further, the aforementioned exhaust control assembly 20 is threaded to a distal body end portion of the load brake tool 18 rather than a medial body portion. *See* col. 3, lines 36-44. Having a counter (actuation plunger) in a medial body portion or proximal end portion rather than the distal body end portion of a circuit interrupting apparatus is an important feature because a counter (including actuator) located on the distal body end portion would not readily be configured to detect full or near-full extension of the device, which is the best indication of actual use. Rather, such distal body end portion configuration disadvantageously is more apt to count inadvertent partial extension resulting less inaccurate usage documentation, incorrect maintenance scheduling, and possibly premature retirement of the circuit interrupting apparatus.

Correspondingly, the independent Claims 1, 11, 21, and 22, as amended, and all dependent claims including Claims 2-3, 6, 7-10, 12-13, and 16-20, as amended, and the newly added Claims 23-30, should be held allowable. The Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the above-described claims.

Still further, the dependent claims have independent novelty. For example, neither Nicolai et al. nor Wood et al. disclose, teach, or suggest: a roll pin connected to a reset plunger which engages a click-over lever, as featured in Claims 2 and 12; means for engaging a counter incrementor switch that is responsive to movement of a reset plunger in a longitudinal direction, as featured in Claims 3, and 13, or one having a plurality of amperage range categories, as featured in Claims 6 and 16; a reset plunger extension, as featured in Claims 7, 17, and 25; an operation counter housing front opening allowing passage of the reset plunger through an operational counter housing, as featured in Claims 8, 18, and 25; an operational counter that is non-resettable by a field operator, as featured in Claims 9 and 19; a fastener to fasten the operation counter housing to a medial portion of the main housing body of the circuit interrupting apparatus, as featured in Claims 10 and 20; or a counter incrementor switch positioned to increment a count of the operation counter responsive to extension of at least portions of a reset plunger through an opening in the main sleeve body, as featured in Claims 24, 27, and 30.

**Claim 21 is not Anticipated.**

The Examiner also rejected Claim 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,300,585 by Nicolai et al. The Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, whereby the identical invention must be shown in as complete detail as is contained in the claim.

Nicolai et al. does not set forth each and every element featured in Claim 21. For example, Nicolai et al. fails to disclose, teach, or suggest providing an operational counter housing front side opening for allowing passage of a reset plunger through the operation counter housing and an operational counter having an operational counter housing backside opening adapted to interface with a reset plunger protruding through a main housing body outer surface. As described previously, the Application describes a reset plunger (76) as a device that is structurally configured to releasably lock sleeve (36) in its extended position until manually released by user manipulation of the reset plunger (76). *See* Application para. [0038]. Further, Nicolai et al. does not disclose, teach, or suggest fastening an operational counter housing to a *medial* body portion of a main body housing of the load break tool 18 (FIG. 1). Referring to Nicolai et al. FIG. 1, the Nicolai et al. operation counter arrangement 10 is instead fastened to an exhaust control assembly 20 located on a distal end portion.

Please note, in commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions or making any amendments herein to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicants' present invention have been made by Applicants. For the foregoing reasons, the Applicants reserve the right to submit additional evidence showing the distinctions between Applicants invention to be novel and nonobvious in view of the prior art.

In re Application of:  
David L. Franklin, et al.

Serial No. 10/734,468

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention that render it patentable, being only examples of certain advantageous features and differences which Applicants' attorney chooses to mention at this time.

### CONCLUSION

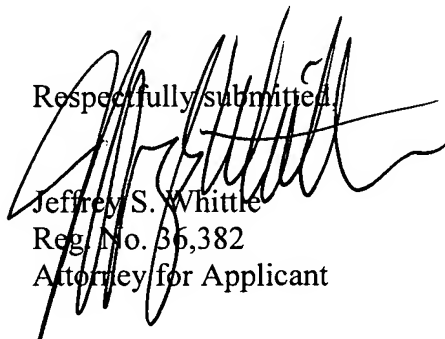
In view of the amendments and remarks set forth herein, Applicants respectfully submit that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

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Respectfully submitted,



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